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EXAMINER

GENACK, MATTHEW W

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/941,265  
Filing Date: August 28, 2001  
Appellant(s): CHO, HAN S.

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Roland K. Bowler II  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4 April 2006 appealing from the Office action mailed 16 December 2005.

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**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

2002/091754

Jang et. al.

12-2000

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5710810	Tiilikainen	1-1998
5535258	Joglekar	7-1996
2003/0017839	Mager	7-2001

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 5, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Joglekar *et. al.*, U.S. Patent No. 5,535,258.

Regarding Claims 1 and 5, Joglekar *et. al.* discloses a radio telephone interface apparatus that allows a user to quickly dial stored telephone numbers (Abstract, Column 3 Lines 11-14). A single key is pushed a number of times corresponding to the directory location associated with the stored telephone

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number that the user wishes to call, and said telephone number is automatically dialed (Column 10 Lines 15-49, Figs. 3-8). It is inherent that the successive key inputs (and therefore the last key input) must be maintained for a certain time interval, for if a key is depressed for a short enough interval, the processor to which it is connected will not detect said key depression. This is the case because the switch associated with said key will not be actuated if said key is not depressed for a minimum time interval.

Regarding Claim 2, a stored directory telephone number is associated with sequential depressions of the same input key, as outlined in the rejection of Claim 1.

Regarding Claim 12, Joglekar *et. al.* discloses a radio telephone interface apparatus that allows a user to quickly dial stored telephone numbers (Abstract, Column 3 Lines 11-14). A single key is pushed a number of times corresponding to the directory location associated with the stored telephone number that the user wishes to call, and said telephone number is automatically dialed (Column 10 Lines 15-49, Figs. 3-8). It is inherent that the successive key inputs (and therefore the last key input) must be maintained for a certain time interval, for if a key is depressed for a short enough interval, the processor to which it is connected will not detect said key depression. The wireless telephone of the invention has a processor, memory, and a keypad with a plurality of keys (Fig. 8).

3. Claims 1-2, 5, 9, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Jang *et. al.*, U.S. Patent Application Publication 2002/0091754.

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Regarding Claims 1 and 5, Jang *et. al.* discloses a procedure whereby a connection code is entered on a wireless telephone terminal's keypad, said code being a shortcut for a telephone number, said telephone number being dialed when the last button is held for a minimum time ([0054], Figs. 3-4).

Regarding Claim 2, the combination of numbers in the code may be anything ([0055]), and thus a string of the same number is permissible.

Regarding Claim 9, Jang *et. al.* discloses a method by which the user of an Internet-enabled cellular telephone can access a given URL (Abstract, Fig. 1). In order to access the site associated with the URL, the cellular telephone must transmit the URL. In particular, the depression of a particular key for longer than normal will load the website associated with the URL (which is stored in the telephone) that is associated with that particular key ([0057]).

Regarding Claim 12, Jang *et. al.* discloses a procedure whereby a connection code is entered on a wireless telephone terminal's keypad, said code being a shortcut for a telephone number, said telephone number being dialed when the last button is held for a minimum time ([0054], Figs. 3-4). The combination of numbers in the code may be anything ([0055]), and thus a string of the same number is permissible. The presences of a processor and memory are inherent to the wireless telephone of the invention.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

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be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-4, 6-8, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jang *et. al.* in view of Tiilikainen, U.S. Patent No. 5,710,810.

Jang *et. al.* discloses every limitation of Claims 1, 5, and 12, upon which Claims 3-4, 6-8, and 13-17 depend, respectively, as outlined above.

Jang *et. al.* does not expressly disclose the feature whereby at least two separate telephone numbers are associated with one name on the wireless telephone's calling list.

Tiilikainen discloses the feature whereby a given individual on the user's list may have more than one telephone number associated with him, in the context of quick dialing from a mobile telephone (Column 1 Line 62 to Column 2 Line 11).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Jang *et. al.* by combining the feature whereby a given individual on the user's list may have more than one telephone number associated with him, with the feature of the invention of Jang *et. al.* in which different numbers of depressions of one input key causes the retrieval of different telephone numbers from memory, with the combined result of depressing a certain key any of a given number of times is the retrieval of one of many telephone numbers associated with one individual.

One of ordinary skill in the art would have been motivated to make this modification because it would make it easier to memorize the key-individual

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correspondences, and because of the convenience of calling a given individual at any particular telephone number associated with that individual.

6. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jang *et. al.*

Jang *et. al.* discloses every limitation of Claim 9, upon which Claims 10-11 depend, as outlined above. However, the embodiment of Jang *et. al.* used in this rejection does not disclose the use of sequential depressions of the same input key. In another embodiment, Jang *et. al.* discloses that the combination of numbers in the code used for speed-dialing may be anything ([0055]), and thus a string of the same number is permissible.

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to combine these two embodiments of the invention of Jang *et. al.* so that sequential depressions of one key result in the Internet-enabled cellular telephone accessing the URL associated with said number of sequential depressions of said key.

One of ordinary skill in the art would have been motivated to combine these features because of the convenience offered to the user of being able to access a website with a small number of keystrokes, and because of the decreased probability of not reaching the website on the first attempt because of an accidental depression of the wrong key.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jang *et. al.* in view of Tiilikainen.



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Further in view of the rejection of Claim 17, upon which Claim 18 depends, Jang *et. al.* discloses that the combination of numbers in the code may be anything ([0055]), and thus said code may consist of two adjacent integers in the range 0 to 9.

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jang *et. al.* in view of Tiilikainen, further in view of Mager, U.S. Patent Application Publication 2003/0017839.

Jang *et. al.* in view of Tiilikainen discloses every limitation of Claim 13, upon which Claim 19 depends, as outlined above.

Neither Jang *et. al.* nor Tiilikainen discloses the use of a mobile wireless communication device that has email features.

Mager discloses a mobile electronic communication device that may store telephone numbers, email addresses, and URLs ([0027] Lines 1-3).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Jang *et. al.* as modified by Tiilikainen by using a wireless telephone that stores email addresses in addition to telephone numbers and URLs.

One of ordinary skill in the art would have been motivated to make this modification because of the increased flexibility offered to the user when he is able to store email addresses in his wireless telephone.

9. Claims 3-4, 6-8, and 13-17 are rejected under 35 U.S.C. 103(a) as being obvious over Joglekar *et. al.* in view of Tiilikainen.

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The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

The rejection of these Claims is parallel to that of Paragraph 5 of this Office Action, with instances of "Jang *et. al.*" being replaced by "Joglekar *et. al.*"

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being obvious over Joglekar *et. al.* in view of Tiilikainen, further in view of Mager.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C.

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103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

The rejection of this Claim is parallel to that of Paragraph 9 of this Office Action, with instances of "*Jang et. al.*" being replaced by "*Joglekar et. al.*"

#### **(10) Response to Argument**

Regarding Appellant's argument, on Page 4, that the declaration in question supports conception of an Internet-enabled wireless communications, while the Motorola Patent Committee document discusses Appellant's conception of his invention, there is insufficient complete conception of all limitations of the current claims. Specifically, said document does not disclose Internet enabled mobile wireless communication devices, nor anything related to

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the Internet in general. Specifically, the lack of mention of anything pertaining specifically to the Internet in Motorola Patent Committee document indicates a lack of conception of the claimed invention, regardless of the existence of other devices at the time of the invention that combined two or more features of the claimed invention (in this case, cellular telephones and the ability to access the Internet) because the conception of an invention entails the mental act of explicitly combining every critical element of said invention together in a specific way, or ways. Though “network address” may refer to a URL, “network address” may also refer to a telephone number. Note that the original invention disclosure teaches associating different types of network address information including only home, cell, pager, and office telephone numbers. Thus, the mention of “network addresses” in the original invention disclosure does not establish conception specifically for Internet use. As a result, Applicant’s Declaration fails to establish disclosure of an Internet address.

Regarding Appellant’s argument, on Pages 4-5, that the declaration in question establishes diligence, this question is relative to formal sufficiency and propriety of affidavits under 37 C.F.R. 1.131 which is not subject to appeal (see MPEP 715.08).

Examiner directs Appellant’s attention to Appellant’s arguments, on Pages 5-9 of the Appeal Brief, pertaining to the 35 U.S.C. 102(e) rejections of Claims 1-2, 5, and 12 under *Joglekar et. al.*, in particular, to the assertions that “maintaining” means depressing and holding an input key for some minimum or predetermined time interval other than what is required to actuate the switch” and

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that "Joglekar does not disclose "maintaining" the input key beyond what is necessary to actuate the switch as recited in Claims 1, 2, 5, and 12". First, neither Claims 1, 2, 5, nor 12 recite a minimum input time interval. Joglekar *et. al.* teaches the depression of a key within a predetermined time period, which causes the processor to initiate automatic dialing of a telephone number stored in the first directory location (Column 10 Lines 15-38). Second, the features upon which Appellant relies (i.e., maintaining the input key beyond what is necessary to actuate the switch) are not recited in the Claims. Note that there is no limitation to the effect that " "maintaining" means depressing and holding an input key for some minimum or predetermined time interval other than what is required to actuate the switch" in any of these Claims. Third, the Appellant cited the American Heritage Dictionary of the English Language, Fourth Edition for the definition of "maintaining" as "To keep in an existing state; preserve or retain: maintain one's composure" on Page 6 of the Appeal Brief. Clearly, this definition of "maintaining" as cited by Appellant does not involve depressing and holding an input key for some minimum or predetermined time interval other than what is required to actuate the switch. According to the American Heritage Dictionary, "maintaining" can be broadly interpreted as "to keep in an existing state". In addition, Joglekar *et. al.* clearly teaches the depression of a key within a predetermined time period causing the processor to initiate automatic dialing of the telephone number stored in the first directory location (Column 10 Lines 15-38). Therefore, these Claims are met by Joglekar *et. al.*

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Examiner directs Appellant's attention to the arguments, on Pages 9-13 of the Appeal Brief, pertaining to the 35 U.S.C. 103(a) rejections of Claims 3-4, 6-8, and 13-17, under Jang *et. al.* in view of Tiilikainen. Contrary to Appellant's assertion that "Jang does not disclose speed dialing by associating a communication address with multiple strokes of the same input key", Jang *et. al.* does disclose speed dialing via the use of a code that involves multiples strokes of the same input key because Jang *et. al.* discloses that a long depression of a single key, such as "1", may be used for shortcut dialing, or that any sequence of keys may be used for shortcut dialing ([0054]-[0055]). Therefore, Jang *et. al.* discloses the limitation "associating the first communication address with a single input from a first input key, associating the second communication address with at least two sequential inputs from the first input key". Additionally, Tiilikainen discloses the feature whereby a given individual on the user's list may have more than one telephone number associated with him, in the context of quick dialing from a mobile telephone (Column 1 Line 62 to Column 2 Line 11). Therefore, Jang *et. al.* as modified by Tiilikainen does involve "associating more than one communication address related to a common identifier with corresponding inputs of the same key", contrary to this assertion on Page 10 of the Appeal Brief. Thus the relevance of Tiilikainen is clear and Claims 3-4, 6-8, and 13-17 stand rejected under 35 U.S.C. 103(a). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of

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references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

On Page 3 of the Appeal Brief, under the heading "Grounds of Rejection for Review on Appeal" Appellant listed the issue "Whether Claim 19 is patentable over Joglekar in view of Tiilikainen and Mager under 35 USC 103(a)". However, Appellant failed to present any argument regarding this issue. Thus, the rejection of Claim 19 under Joglekar *et. al.* in view of Tiilikainen, further in view of Mager, is maintained.

**(11) Conclusion**

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Matthew Genack



Examiner

TC-2600, Division 2617

Conferees:



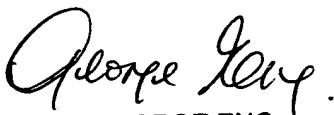
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